UNITED STATES PATENT AND TRADEMARK OFFICE

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10/612,506	07/02/2003	Motoaki Aoyama	KOT-0078	3507

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EXAMINER
NGUYEN, ALLEN H

ART UNIT	PAPER NUMBER
2625	

NOTIFICATION DATE	DELIVERY MODE
03/02/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

usptopatentmail@cantorcolburn.com

	Application No.	Applicant(s)
	10/612,506	AOYAMA ET AL.
Office Action Summary	Examiner	Art Unit	
	Allen H. Nguyen	2625	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>26 November 2008</u>.

2a)☒ This action is FINAL.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-42</u> is/are pending in the application.

    4a) Of the above claim(s) <u>16-42</u> is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-15</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>13 December 2004</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All b)☐ Some * c)☐ None of:

      1.☒ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.
5)☐ Notice of Informal Patent Application
6)☐ Other: _____.

DETAILED ACTION

- This office action is responsive to the following communication:

  Amendment filed on 11/26/2008.

- Claims 1-42 are currently pending, with claims 16-42 being withdrawn, in

  the application.

Response to Arguments

1.   Applicant's arguments filed 11/26/2008 have been fully considered but they are

not persuasive.

2.   With respect to applicant's argument that "Okimoto does not teach or suggest the

receiving section of claim 1 that is structured to receive both image data and post

processing data.

        In reply: Okimoto teaches the receiving section of claim 1 that is structured to

receive both image data (column 23, line 16) and processing data (e.g., number of

sheet onto which the print data is desired to be printed, column 12., lines 55-60).

        Okimoto '926 does not explicitly show said processing data include post

processing data, post processing data is defined as such a physical treatment that is to

be applied to said print product after said whole image forming process is completed, so

as to physically change an appearance and/or a binding mode of said print product.

        However, the above-mentioned claimed limitations are well known in the art as

evidenced by Harris '717. In particular, Harris '717 teaches said post processing is

defined as such a physical treatment that is to be applied to said print product after said whole image forming process is completed (the user can instruct the digital transmitting device to perform such post-processing as binding, collating, folding, stacking, stapling, stitching, edge-trimming, paginating, and printing on substrates of varied composition; Col. 4, lines 64-67), so as to physically change an appearance and/or a binding mode of said print product (With respect to step 14, the post-processing instructions, if any, are carried out upon the document on the destination device; Col. 5, lines 49-53, fig. 1B).

In view of the above, having the system of Okimoto and then given the well-established teaching of Harris, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify the system of Okimoto as taught by Harris to include: said post processing is defined as such a physical treatment that is to be applied to said print product after said whole image forming process is completed, so as to physically change an appearance and/or a binding mode of said print product, since Harris stated in col. 1, lines 5-10, that such a modification would ensure a system providing information regarding the auto-routing transmittal of the document to the desired recipient, and providing information regarding any post-processing of the document.

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4.   Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Okimoto et al. (US 6,268,926) in view of Harris (US 6,799,717).

        Regarding claim 1, Okimoto '926 discloses an apparatus (4, fig. 3) that receives

an electronic mail (i.e., the apparatus that the print mail reception utility 31b is for

receiving electronic mail; Col. 9, lines 5-6), and creates a print product based on image

data included in said electronic mail (i.e., the print mail reception utility 31b prints the

print data included in the file attached to the print mail if needed, and also prints the

contents of the ordinary mail, that is, the message included in the ordinary mail and the

file attached to the mail; Col. 32, lines 25-65, figs. 22- 23, 26, 28-29), said image

forming apparatus comprising:

        a receiving section (the mail reception system, col. 5, lines 25-35) to receive said

electronic mail including said image data (The computer on the receiving end can

directly extract the print data from the mail and then output that data directly to the

printer. Therefore, allowing the receiver to directly obtain printed material of the

received mail data from the printer; Col. 1, lines 45-55) and processing data

representing a processing to be applied to said print product created on the basis of

said image data (allowing the user on the receiving end to view the document by the

compacting or reducing process is, for example, a process for reducing the size of a

print pattern defined by one page's worth of print data so that reduced print patterns

defined by more than one pages' worth of print data can be printed onto one sheet of

paper ; Col. 6, lines 60-67), wherein said print product includes a single paper sheet or

a plurality of paper sheets (i.e., the number of pages of print data to be printed onto one

sheet of paper; Col. 7, lines 1-5), on each of which an image is already formed through

a whole image forming process based on said image data (i.e., the print data is

described, and the number of sheets, onto which the print data is desired to be printed;

Col. 7, lines 60-65),

an acquiring section (Printer Driver 30, fig. 3) to acquire said image data and said

processing data (i.e., image data and four pages' worth of data is converted into a one-

page layout; Col. 23, lines 15-20), separately from said electronic mail (POP Server 38,

fig. 3);

a processing data judging section (Print Mail Reception Utility 31b, fig. 3) to

determine whether or not said processing (i.e., the present print mail reception utility

process 31b is executed on the computer system 8 side, the process of S984 is

executed to, judge whether the printer 6 is set to the page description language, a page

description language specifies the arrangement of a printed page through commands

from a computer that the printer carries out, as determined in S982; Col. 22, lines 15-20,

and fig. 14), represented by said processing data (i.e., it is noted that at least a process

for reducing the size of a print pattern defined or data indicating whether the print data

included in the attached file is representative of a single color image or a full color

image; Col. 6, lines 64-67 and Col. 26, lines 10-15), is provided in said image forming

apparatus itself as an applicable post processing (i.e., a print process setting; Col. 11,

line 65; Col. 12, lines 15-25);

a determining section (Transmission Command CPU 132, fig. 2b) to determine

whether or not said processing data should be changed (i.e., It is noted that when the

present print mail reception utility process 31b is executed on the computer system 8

side, the process of S984 is executed to, judge whether the printer 6 is set to the page

description language as determined in S982; see col. 22, lines 15-20, fig. 14), when

said processing data judging section determines that said processing is not provided in

said image forming apparatus itself (NO in S984, fig. 14),

an establishing section (print mail reception utility process, fig. 3) to establish a

set of finish-setting items representing post processing (i.e., 4 in- 1 finishing information,

fig. 15, S995) to be applied to said print product based on a result made by said

determining section (a program of a print mail reception utility 31b shown in FIGS. 8-

17).

Okimoto '926 does not explicitly show said post processing is defined as such a

physical treatment that is to be applied to said print product after said whole image

forming process is completed, so as to physically change an appearance and/or a

binding mode of said print product.

However, the above-mentioned claimed limitations are well known in the art as

evidenced by Harris '717. In particular, Harris '717 teaches said post processing is

defined as such a physical treatment that is to be applied to said print product after said

whole image forming process is completed (the user can instruct the digital transmitting

device to perform such post-processing as binding, collating, folding, stacking, stapling,

stitching, edge-trimming, paginating, and printing on substrates of varied composition;

Col. 4, lines 64-67), so as to physically change an appearance and/or a binding mode of said print product (With respect to step 14, the post-processing instructions, if any, are carried out upon the document on the destination device; Col. 5, lines 49-53, fig. 1B).

In view of the above, having the system of Okimoto and then given the well-established teaching of Harris, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify the system of Okimoto as taught by Harris to include: said post processing is defined as such a physical treatment that is to be applied to said print product after said whole image forming process is completed, so as to physically change an appearance and/or a binding mode of said print product, since Harris stated in col. 1, lines 5-10, that such a modification would ensure a system providing information regarding the auto-routing transmittal of the document to the desired recipient, and providing information regarding any post-processing of the document.

Regarding claim 2, Okimoto '926 discloses the apparatus (4, fig. 3), wherein said acquiring section (Printer Driver 30, fig. 3) includes an electronic mail analyzing section (CPU 132, fig. 2b) to analyze said electronic mail so as to acquire said image data (i.e., the print mail transmission utility 31a is executed by the CPU 132 when a print mail transmission instruction is issued from the printer driver 30; Col. 9, lines 1-5) and said processing data (i.e., image data and four pages' worth of data is converted into a one-page layout; Col. 23, lines 15-20), separately from said electronic mail (POP Server 38, fig. 3).

Regarding claim 3, Okimoto '926 discloses the apparatus (4, fig. 3), further

comprising: a processing content storing section (RAM 133, fig. 2b) to store a content of

post processing provided in advance (a RAM 133 for preparing a storage area for

temporarily storing print data to be transmitted to a transfer destination; Col. 8, lines 27-

30) in said image forming apparatus itself (4, fig. 3) as applicable processing (a print

process setting, col. 11, line 65).

Regarding claim 4, Okimoto '926 discloses the apparatus (4, fig. 3),

wherein, when said finishing information judging section (Print Mail Reception

Utility 31b, fig. 3) determines that said processing (a print process setting, col. 11, line

65) is provided in said apparatus itself (4, fig. 3), said establishing section (Printer

Selecting and Setting Process, fig. 14) establishes said set of setting (S984, fig. 14),

according to said processing data directly acquired from said electronic mail (Select the

Appropriate Printer for Print Output S987, fig. 14).

Regarding claim 5, Okimoto '926 discloses apparatus (4, fig. 3), wherein said

electronic mail analyzing section includes a processing data rule storing section to store

a rule with respect to a description of said processing data (i.e., the header 50b of the

print mail further includes print information (processing format data) such as an

indicative rule of how the print data included in the attached file is desired to be printed

at the transfer destination; Col. 7, lines 53-60), and analyzes said electronic mail data

based on a content stored in said information processing data rule storing section to

acquire said processing data, when analyzing said electronic mail (i.e., file attributes

such as a page description language (emulation), at which the print data is described,

and the number of sheets (finishing information), onto which the print data is desired to

be printed; Col. 7, lines 62-65).

    Regarding claim 6, Okimoto '926 discloses the apparatus (4, fig. 3), wherein said

processing data rule storing section stores a tag description (i.e., the process in S982

may be modified to determine whether the mail header includes processing format data

indicating that the print data in the attached file is representative of a full color image;

see col. 26, lines 10-20) and said processing data while correlating them with each

other (i.e., the file attributes as print information, included in the mail header include

codes indicative of the page description language; Col. 26, lines 5-7).

    Regarding claim 7, Okimoto '926 discloses the apparatus (4, fig. 3), further

comprising: a notifying section to notify a sender of said electronic mail (Return to

Sender Specified in S630, fig. 11), when said processing data judging section

determines that said processing is not provided in said image forming apparatus itself

(i.e., if there exists no printer having this function to interpret the page description

language as determined in S982 ("no" in S985), then in S988 a message is displayed in

the mail log window 52 indicating that the current print mail is unprintable; Col. 22, lines

40-45, and fig. 14, Print Mail is Unprintable S988).

Regarding claim 8, Okimoto '926 discloses the apparatus (4, fig. 3), wherein said

notifying section notifies said sender of a fact that said post processing (Return to

Sender Specified in S630, fig. 11), represented by said processing data (Printer

Selecting and Setting Process, fig. 14), is not provided in said image forming apparatus

itself as said applicable processing (Indicate in mail log that print mail is unprintable in

S988, fig. 14), and of another applicable processing corresponding thereto (Switch

printer setting to appropriate function in S986, fig. 14).

Regarding claim 9, Okimoto '926 discloses the apparatus (4, fig. 3), further

comprising: a notifying section to notify a sender of said electronic mail of content (i.e.,

the program determines in S993, based on the contents of its mail log data (mail

header); see col. 22, lines 53-55, fig. 15) of processing applicable in said image forming

apparatus itself (i.e., the page description language describing the subject print data is

converted in S995 so that print data equivalent to four pages before conversion is

reduced to one page of print data; Col. 23, lines 8-10, fig. 15).

Regarding claim 10, Okimoto '926 discloses the apparatus (4, fig. 3),

wherein said applicable processing differs depending on a sender of said

electronic mail (i.e., the print mail is transmitted to a receiving end (transfer destination)

as specifically desired by a sender to be printed at the transfer destination. The cancel

mail is transmitted to the receiving end (transfer destination) of the print mail as

instructed by the sender to cancel printing of the print mail; Col. 7, lines 30-35).

Regarding claim 11, Okimoto '926 discloses the apparatus (4, fig. 3), further

comprising: an individual-sender processing storing section to store identifying

information for an individual-sender and a finishing content, which is allowed for said

individual-sender, while correlating them with each other (i.e., the header 50b of the

ordinary mail includes: a message ID identifying that mail; an address of a mail server

(24 or 28) connected to the sender; an address of the transfer destination; a subject of

the mail; and the like; Col. 7, lines 44-49, and fig. 18, Mail Structure).

Regarding claim 12, Okimoto '926 discloses the apparatus (4, fig. 3), further

comprising:

a sender rejecting section to stop an image-forming operation based on said

image data included in said electronic mail, when an address of a sender coincides with

a rejecting address established in advance (i.e., the cancel mail is transmitted by the

mail server 24 to the Internet 28, along which the cancel mail is transferred until

eventually arriving at the a destination. The computer system at the destination address

will attempt to prevent the printing of the print mail indicated by the one or more cancel

message IDs included in the cancel mail. The computer system will delete data of the

print mail; Col. 14, lines 42-49).

Regarding claim 13, Okimoto '926 discloses the apparatus (4, fig. 3), further

comprising:

a sender restricting section to allow an image-forming operation based on said

image data included in said electronic mail, only when an address of a sender coincides

with an allowed address established in advance (i.e., the header 50b of the ordinary

mail includes: a message ID identifying that mail; an address of a mail server (24 or 28)

connected to the sender; an address of the transfer destination; a subject of the mail;

Col. 7, lines 46-49, and fig. 1).

Regarding claim 14, Okimoto '926 discloses the apparatus (4, fig. 3), further

comprising:

an image-forming section to conduct an image-forming operation based on said

image data (i.e., the process of S983 may be modified to set a printer, which is capable

of interpreting the page description language of the print data and which is capable

printing the color-printing type of the print data, to a function mode to interpret the page

description language of the print data and to print the print data at the corresponding

color-printing type; Col. 26, lines 35-40, and fig. 13).

Regarding claim 15, Okimoto '926 discloses the apparatus, further comprising:

a processing section to apply said post processing to said print product (i.e., the

print mail reception utility 31b is for receiving electronic mail addressed to the apparatus

4 and for executing processing operations in correspondence with the contents of the

mail; Col. 9, lines 5-10);

wherein said <u>processing</u> section performs processing (Reduce 4 pages of print

data to 1 page in S995) based on said set of setting <u>items</u> (i.e., a print process setting;

Col. 11, line 65).

Conclusion

5.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

Nakai et al. (US 5,909,602) discloses an electronic RDH set key is displayed on

the post-processing setting screen.

Nagashima (US 5,466,328) discloses a post-processing unit connected to a

recorded sheet discharge section of an electronic copying machine.

Tamura (US 7,317,545) discloses a staple processing means to perform the

stapling process as a post-processing means.

6.   THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

7.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Allen H. Nguyen whose telephone number is (571)270-

1229. The examiner can normally be reached on 9:00 AM-6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, KING Y. POON can be reached on (571) 272-7440. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/King Y. Poon/
Supervisory Patent Examiner, Art Unit 2625

/Allen H. Nguyen/
Examiner, Art Unit 2625